

- Group IV: Claims 17, 35, and 45, drawn to a process for preparing an ultraphobic surface;
- Group V: Claims 18-25, 36-44, and 46, drawn to a process for preparing an ultraphobic surface; and
- Group VI: Claims 26 and 47-51, drawn to a method of testing surface properties of ultraphobic surfaces.

Applicants elect, with traverse, Group I, Claims 1-10 and 27-28.

Applicants traverse the Restriction Requirement on the grounds that the claims of Group II are directly dependent from the claims of Group I, and as such these claims cannot be separated.

The Examiner contends that Groups IV-VI do not relate to a single general inventive concept with Groups I-III . Applicants wish to point out that MPEP 1893.03 (d) states that:

A group of inventions is considered linked to form a single general inventive concept where there is a technical relationship among the inventions that involves at least one common or corresponding special technical feature.

Group I-VI do share a common technical feature, an ultraphobic surface having a hydrophobic or oleophobic material. Accordingly, the criteria for unity of invention are satisfied.

The Examiner, citing PCT Rule 13.1 and 13.2, contends that a lack of unity exists between Groups I-VI, because the special technical feature of the present invention does not define a contribution over the prior art. To support this assertion, the Office merely states its conclusion and cites US 5,277,788 from the International Search Report. However, the Office's assertion is misplaced. In Section 2, paragraph 2, of the International Preliminary Examination Report (submitted herewith) the International Search Authority finds that "novelty over D2 (US 5,277,788) can be acknowledged in the subject matter of the

application.” Accordingly, the Office has not made out a proper case under the PCT Rules to support the Restriction Requirement, and as such should be withdrawn.

Moreover, MPEP 1893.03 (d) states:

When making a lack of unity of invention requirement, the Examiner must... (2) explain why **each** group lacks unity with each other group (i.e., why there is no single general inventive concept) specifically describing the unique special technical feature in each group.

Applicants submit that the Examiner has not met this requirement. As a result, the restriction is not sustainable and should be withdrawn.

Applicants traverse that Restriction Requirement on the additional grounds that the Office has not applied the same standard of unity of invention as the International Preliminary Examination Authority (see copy appended herewith). The Authority did not take the position that unity of invention was lacking in the International application and examined all claims together. Applicants note that PCT Article 27(l) states:

No national law shall require compliance with requirements relating to the form or contents of the international application different from or additional to those which are provided for in this Treaty and the Regulations.

Moreover, Applicants respectfully traverse on the grounds that the Office has not shown that a burden exists in searching the entire application.

MPEP in §803 states as follows:

If the search and examination of an entire application can be made without a serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.

Applicants respectfully submit that a search of all the claims would not impose a serious burden on the Office. In fact, the International Searching Authority has searched all of the claims together.

For the reasons set forth above, Applicants contend that the Restriction Requirement is improper and should be withdrawn.

Applicants respectfully submit that the above-identified application is now in condition for examination on the merits, and early notice of such action is earnestly solicited.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT, P.C.



Norman F. Oblon  
Attorney of Record  
Registration No.: 24,618

Vincent K. Shier, Ph.D.  
Registration No.: 50,552



**22850**

PHONE: (703) 413-3000  
FAX: (703) 413-2220  
NFO:VKS  
I:\atty\VKS\209774US0PCT-RR RESP.wpd